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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,541	07/27/2001	Katrin Reisinger	GTP/US 3183	9996
24131	7590	11/17/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			GREENE, DANIEL L	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 11/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,541

Applicant(s)

REISINGER, KATRIN

SO

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/27/2004 have been fully considered but they are not persuasive.
2. In reference to the Applicant's review of the invention, the Examiner submits that, Leon discloses a mailing machine including a controller, a security module (SMD), and a non-removable memory operationally connected to the security module and configured to store an initialization program. Leon also discloses an interface circuit utilized for initializing the SMD either locally or remotely. Fig. 1B and 2A. The second reference, VU, discloses the use of a cryptographic key, stored in an encrypted form, residing on a removable storage device, such as a floppy disk, CD-ROM, dongle, etc. Col. 2, lines 62-65, in conjunction with the use of a personal identification number (PIN), to provide the initialization of a program.
3. Leon further discloses the SMD upon power up, performing checks to determine which one of the allowable operating states to enter. Col. 11, lines 24-30. The SMD receives its operating instructions from a PC that is similar to PC operation in the reference VU. Fig. 5B, Col. 13, lines 25-67, provides the procedure and motivation for combining the references Leon and Vu that addresses the limitations of the Applicant's invention.
4. In response to applicant's argument that Leon and Vu are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the

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applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Vu teaches about the use of dongles for the initialization of program and Leon utilizing a remote computer for the initialization of a SMD.

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Vu teaches about the use of dongles for the initialization of program and Leon utilizing a remote computer for the initialization of a SMD.

6. The Examiner agrees with the Applicant that Leon does not disclose a "removable authorization device but submits that the SMD of Leon is an authorization device. Vu is incorporated to teach about the use of a removable authorization device in conjunction with the initialization procedure.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon U.S. Patent 6,424,954 [Leon], and further in view of Vu et al. U.S. Patent 6,557,104[Vu].**

3.

As per claims 1 and 18:

Leon discloses:

a mailing machine including a controller, a security module connected to said controller, and a non-removable program memory operationally connected to said security module and configured to store an initialization program; Col. 13-14, lines 1-67.

said security module being programmed to check whether authorization is present and for preventing an initialization of said mailing machine without authorization. Col. 15, lines 3-15.

Leon discloses the claimed invention except for a removable authorization device being operationally connected to said mailing machine and configured for being interrogated by said mailing machine. However, Leon does disclose an input element that is coupled to an input circuit for initiating an action. Col. 37, lines 46-67.

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Vu teaches that it is known in the art to provide a removable authorization device to be operationally connected to said mailing machine and configured for being interrogated by said mailing machine. Col. 4, lines 20-50.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the input element of Leon with a removable authorization device to be operationally connected to said mailing machine and configured to be interrogated by said mailing machine of Vu, in order to provide flexibility in the use of the mailing machine.

As per claim 2:

Leon further discloses:

wherein said authorization device is indirectly connected to said mailing machine via a data source selected from a group consisting of a personal computer, a laptop, and a remote data center. Col. 4-5, lines 1-67.

As per claim 3:

Leon further discloses:

wherein said authorization device is directly connected to said mailing machine. Col. 4-5, lines 1-67.

As per claim 4:

Leon further discloses:

wherein said mailing machine is a franking machine having a meter with a user interface, for a data input of predetermined values, and a postal security device configured to check an authorization of the data input. Col. 4-5, lines 1-67.

As per claim 5:

Leon further discloses:

wherein said franking machine has a base with a first interface for attachment of said data source containing initialization data for said mailing machine, and a second interface for attachment of said authorization device. Fig. 2A.

As per claim 6:

Leon discloses the claimed invention except for wherein said authorization device is a dongle. However, Leon does teach about data link interfaces. Col. 37, lines 48-60. Vu teaches that it is known in the art to provide data link interfaces wherein said authorization device is a dongle. Col. 2, lines 62-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the data link interfaces of Leon with the said authorization device as a dongle of Vu, in order to provide flexibility in the use of the related equipment.

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As per claim 7:

Leon further discloses:

wherein said data source contains initialization data for said mailing machine and is configured to be attached to said first interface of said base of said mailing machine, and wherein said authorization device is a chip card and a chip card reader is operatively connected to said meter via a further internal interface and arranged to be integrated into said base. Col. 44-45, lines 1-67.

As per claim 8:

Leon further discloses:

wherein said first and second interfaces are serial interfaces. Col. 7, lines 32-42.

As per claim 9:

Leon further discloses:

wherein said interface is a serial interface. Col. 7, lines 32-42.

As per claim 10:

Leon further discloses:

wherein said first interface of said base of said mailing machine is configured for attachment of said data source, said authorization device is connected to said data source via a parallel interface, said data source is a computer and is coupled via a

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serial interface of said mailing machine, and wherein a chip card reader is integrated and operatively connected to said meter via an interface of said meter. Col. 24, lines 45-67.

As per claim 11:

Leon discloses the claimed invention except for wherein said mailing machine is a franking machine with a meter and a chip card reader integrated in said meter and coupled to a parallel bus of said meter via an interface and wherein said authorization device is a chip card.

However, Leon does disclose an input element that is coupled to an input circuit for initiating an action. Col. 37, lines 46-67.

Vu teaches that it is known in the art to provide wherein said mailing machine is a franking machine with a meter and a chip card reader integrated in said meter and coupled to a parallel bus of said meter via an interface and wherein said authorization device is a chip card. Col. 4, lines 20-50.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the input element of Leon with wherein said mailing machine is a franking machine with a meter and a chip card reader integrated in said meter and coupled to a parallel bus of said meter via an interface and wherein said authorization device is a chip card of Vu, in order to provide flexibility in the use of the mailing machine.

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As per claim 12:

Leon further discloses:

wherein said mailing machine is a set of scales, and wherein a chip card reader is integrated into said scales and coupled via an interface of said scales, and wherein said authorization device is a chip card. Col. 1-2, lines 1-67.

As per claim 13:

Leon further discloses:

wherein said mailing machine has a modem and a modem interface for loading they're through the initialization data or values, Col. 42, lines 57-65

Leon discloses the claimed invention except for wherein said authorization device is an insert able chip card, for authorizing at least that part of the INIT data or values which are loaded into said mailing machine from a data source via said modem interface.

However, Leon does disclose an input element that is coupled to an input circuit for initiating an action. Col. 37, lines 46-67.

Vu teaches that it is known in the art to provide wherein said authorization device is an insert able chip card, for authorizing at least that part of the initialization data which are loaded into said mailing machine from a data source via said modem interface. Col. 4, lines 20-50.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the input element of Leon with a wherein said

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authorization device is an insert able chip card, for authorizing at least that part of the INIT data or values which are loaded into said mailing machine from a data source via said modem interface of Vu, in order to provide flexibility in the use of the mailing machine.

As per claim 14:

Leon further discloses:

wherein said mailing machine is a franking machine having at least one program memory with an initialization program and a postal security module, for checking the authorization before and during the initialization, and wherein said postal security module is configured for loading initialization data. Col. 69-79, lines 1-67.

As per claim 15:

Leon further discloses:

wherein a checking of the authorization before and during the initialization is performed on the basis of a unique authorization number, input via a dongle or a chip card and wherein the authorization is given if the unique authorization number input into the mailing machine has a predetermined relationship with a number stored in said postal security module. Col. 75-76, lines 1-67.

As per claim 16:

Leon further discloses:

which comprises a program memory at least partly storing the initialization program, said program memory forming a component part of said security module, and including a separate program memory operatively in connection with said security module and storing another part of the initialization program. Col. 44-45, lines 1-67.

As per claim 17:

Leon further discloses:

wherein the other part of the initialization program is for initialization data stored in a non-volatile manner externally of the security module. Fig. 2A

As per claim 19:

Leon further discloses:

switching a franking machine into the initialization mode and establishing a connection to a data source; Col. 12, lines 5-45.

authorizing initialization with an authorization device;

inputting a battery date BAT.DATE.SAD of a battery of the security module, a telephone number of the teleporting data center TDC of the destination country and a postage call-up number PAN; Col. 23, lines 49-60.

transmitting a serial number SAD-SN of the security module to the teleporting data center TDC of the country, to initialize a comparison of the serial number SAD-SN sent with a stored serial number, and to generate a notification; Col. 22, lines 5-43.

receiving the notification sent by the teleporting data center TDC in the franking machine and loading codes DES-Keys for credit recharging into the security module SAD; Col. 44, lines 5-20.

terminating the initialization and canceling the authorization by removing the authorization device. Col. 73-74, lines 1-67.

As per claim 20:

Leon further discloses:

wherein the establishing step comprises connecting via a transmission device selected from a group consisting of a modem, a laptop, and a PC interface. Col. 5, lines 1-11.

As per claim 21:

Leon further discloses:

which comprises switching into the initialization mode at the goods receiving location in the destination country as a result of activating a means of activating a user interface and establishing a connection to a data source via a transmission device selected from the group consisting of a modem, a laptop, and a PC interface. Col. 5, lines 1-11.

As per claim 22:

Leon further discloses:

comprising sending notification by the telepostage data center TDC including a code MAC-Key for a security imprint, which is received by the franking machine and loaded into the security module SAD. Col. 22, lines 5-43.

As per claim 23:

Leon further discloses:

comprising providing the codes DES-Keys for credit recharging including the sub codes Key(0), Key(i), Kvar and loading the codes into the security module SAD. Col. 44, lines 5-20.

As per claim 24:

Leon further discloses:

comprising sending the notification by the telepostage data center TDC including extra data stored in a non-volatile memory externally of the security module. Col. 5, lines 1-67.

Leon does not expressly show including the inkjet cartridge data.

However this differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The notification sent by the TDC steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579; 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the inkjet cartridge data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 25:

Leon discloses the claimed invention except for wherein the inputting step comprises inputting initialization data with the chip card.

However, Leon does disclose an input element that is coupled to an input circuit for initiating an action. Col. 37, lines 46-67.

Vu teaches that it is known in the art to provide wherein the inputting step comprises inputting initialization data with the chip card. Col. 4, lines 20-50.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the input element of Leon with a wherein the inputting step comprises inputting initialization data with the chip card of Vu, in order to provide flexibility in the use of the mailing machine.

As per claim 26:

Leon does not expressly show comprising providing data input of extra data including inkjet cartridge data and storing the data in a non-volatile memory externally of the security module.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The comprising providing data input of extra data includes inkjet cartridge data and storing the data in a non-volatile memory externally of the security module steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the comprising providing data input of extra data includes inkjet cartridge data and storing the data in a non-volatile memory externally of the security module because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 27:

Leon further discloses:

which comprises interrogating the authorization device before and during the initialization of the mailing machine with predetermined data. Fig. 6A.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/9/2004

DLG

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